

Docket No.: TME-2217

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Before the Board of Patent Appeals and Interferences

Applic. No. : 10/538,168 Confirmation No.: 2243
Inventor : Markus Anliker
Filed : June 9, 2005
Title : Suppository Packaging Device
TC/A.U. : 3728
Examiner : Jose S. Stephens III
Customer No. : 24131

Hon. Commissioner for Patents
Alexandria, VA 22313-1450

BRIEF ON APPEAL

Sir:

This is an appeal from the final rejection in the Office action dated March 26, 2010, finally rejecting claims 1, 4 and 20.

Appellants submit this *Brief on Appeal* including payment in the amount of \$270.00 to cover the fee for filing the *Brief on Appeal*.

Real Party in Interest:

The inventor Markus Anliker is the real party in interest.

Related Appeals and Interferences:

No related appeals or interference proceedings are currently pending which would directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

Status of Claims:

Claims 1, 4 and 20 are rejected and are under appeal. Claims 2-3 and 5-19 have been cancelled.

Status of Amendments:

No claims were amended after the final Office action. The Primary Examiner stated in an *Advisory Action* dated July 12, 2010 that the request for reconsideration had been considered but did not place the application in condition for allowance. A *Notice of Appeal* was filed on July 26, 2010.

Summary of the Claimed Subject Matter:

The subject matter of each independent claim is described in the specification of the instant application. Examples explaining the subject matter defined in each of the independent claims, referring to the specification by page and line numbers, and to the drawings, are given below.

Independent claim 1 reads as follows:

Independent device claim 1 recites a suppository package (*Figs. 2, ref. # 4, paragraph 0015*) comprising:

a package (*Fig. 2, ref. # 4, paragraph 0015*) having a chamber (*Fig. 2, paragraph 0015*) formed therein, said chamber (*Fig. 2, paragraph 0015*) containing a suppository (*Fig. 2, ref. # 1, paragraph 0015*) therein, said package (*Fig. 2, ref. # 4, paragraph 0015*) having a second chamber (*Fig. 2, at ref. # 2, paragraph 0015*) formed therein, said second chamber (*Fig. 2, at ref. # 2, paragraph 0015*) being separate from said chamber (*Fig. 2, paragraph 0015*) and disposed within said chamber (*Fig. 2, paragraph 0015*), and said second

chamber (*Fig. 2, at ref. # 2, paragraph 0015*) containing a lubricant (*Fig. 2, ref. # 2, paragraph 0015*) therein.

Grounds of Rejection to be Reviewed on Appeal

1. Whether or not claims 1 and 20 are obvious over Mumford (U.S. Patent No. 4,093,103) in view of Hermelin et al. (U.S. Patent No. 6,375,956) (hereinafter "Hermelin") under 35 U.S.C. § 103.
2. Whether or not claim 4 is obvious over Mumford (U.S. Patent No. 4,093,103) in view of Hermelin (U.S. Patent No. 6,375,956) and further in view of Davidowitz (U.S. Patent No. 3,712,300) under 35 U.S.C. § 103.

Argument:

Whether claims 1 and 20 are obvious over Mumford in view of Hermelin under 35 U.S.C. §103.

Claims 1 and 20 are not obvious over Mumford in view of Hermelin under 35 U.S.C. §103:

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claim 1 calls for, *inter alia*:

a package having a chamber formed therein, the chamber containing a suppository therein, the package having a second chamber formed therein, the second chamber being separate from the chamber and disposed within the chamber, and the second chamber containing a lubricant therein.

On page 2 of the final Office action dated March 26, 2010, the Examiner states that Mumford discloses "a package 10 comprising a chamber (interior of package outside second chamber 53) formed therein the package having a second chamber 53 formed therein."

Moreover, on pages 2-3 of the final Office action dated March 26, 2010, the Examiner alleges that "Mumford discloses the claimed invention except for the package is a suppository package, the chamber containing a suppository, and the second chamber containing a lubricant."

The Examiner's allegation is not an accurate representation of Mumford. Specifically, the Examiner appears to ignore the fact that Mumford does not disclose that anything is disposed in the area that the Examiner alleges as the "chamber" (Examiner's "interior of package outside second chamber 53"). Furthermore, Mumford explicitly discloses that the Examiner's "chamber" has openings in the rear wall between the surfaces designated by the reference symbols "38" and "42" (column 3, lines 8-22 and figures 1, 3, and 5). Additionally, Mumford explicitly discloses that the construction which requires the openings, is precisely the mechanism by which the container is opened and which also prevents accidental opening of the container (child resistance). Furthermore, Mumford explicitly discloses that the purpose of the container is to store products in a sealed chamber (i.e. chamber 53). Therefore, Mumford does not disclose disposing items in the unsealed area of the container that the Examiner considers the "chamber". In fact, because Mumford discloses to dispose objects only in the sealed chamber (53) and the purpose of container disclosed by Mumford is to store objects in a sealed watertight manner, Mumford explicitly teaches away from disposing any items in the area that the Examiner considers as the "chamber" (due to the openings in the rear

wall 22). As such, the Examiner's above-noted allegation is not an accurate representation of Mumford.

Furthermore, on page 3 of the final Office action dated March 26, 2010, the Examiner alleges that based on Hermelin "it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the package of Mumford by placing a suppository in the chamber and a lubricant (cream) in the second chamber."

The Examiner's allegation is in error. Specifically, as indicated above, Mumford does not disclose to dispose anything in the area that the Examiner alleges is the "chamber". Also, as shown above, Mumford explicitly discloses that the "chamber" is not sealed. Furthermore, Mumford explicitly discloses to store objects in a sealed chamber. Therefore, Mumford explicitly teaches away from the Examiner's allegation. Additionally, any products disposed in the area that the Examiner alleges as the "chamber", such as a suppository (or lubricant) would be susceptible to unacceptable contamination. Accordingly, the Examiner's allegation with respect to the modification of Mumford based on Hermelin, is in error.

Moreover, the Examiner is reminded that in MPEP 2143 states that:

VI. THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A REFERENCE

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)

As noted above, Mumford explicitly discloses that the container is provided to dispose products in a sealed internal chamber of a container. As seen from the above-given remarks, disposing product in the area of the container alleged by the Examiner would place product in a chamber that is not sealed. Therefore, the modification of Mumford as alleged by the Examiner would in fact change the principle of operation of the container of Mumford, as product disposed in the area that the Examiner alleges as the "chamber" of the container would not be sealed due to the openings in the rear wall of the container, thereby changing the principle of operation of the container of Mumford. Accordingly, according to MPEP 2143, because the modification of Mumford as alleged by the Examiner would necessarily change the

principle of operation of Mumford, the teachings of the references are not sufficient to render the claims *prima facie* obvious.

In the advisory action the Examiner alleges that "applicant's argument that the chamber of Mumford is not sealed is not persuasive because claim 1 does not claim that any chamber is sealed."

The Examiner's allegation is misplaced and patently wrong. Specifically, appellant never argued that claim 1 recited that the chambers are sealed. Instead, appellant's argument against the obviousness rejection is in fact properly based on what is explicitly disclosed by Mumford, namely to provide a sealed chamber for storing objects. Therefore, based on the explicit disclosure of Mumford, there is no motivation to dispose a suppository in the unsealed area that the Examiner alleges as the "chamber". Accordingly, the Examiner's allegation with respect to what is claimed in claim 1 of the instant application, is misplaced and patently wrong.

In the advisory action the Examiner alleges that "Mumford states 'the rearward portion of side walls 18 of the lid 12 are provided with complementary downward and outwardly sloping opposed cam

surfaces 50 which, when the container is in a closed position, closely abut or even contact surfaces 48 in a generally flush-like manner' which means the entire container can be sealed."

The Examiner's allegation is patently wrong. Specifically, as noted above, Mumford explicitly discloses to provide openings in the rear wall (22) of the container. Mumford discloses that the openings are specifically provided for facilitating the opening and secure closing of the container. Mumford discloses that the openings are present when the container is closed. Therefore, contrary to the Examiner's allegation, the entire container is not and cannot be sealed.

Accordingly, as seen from the above-given remarks, the Examiner's allegation with respect to sealing of the container, is patently wrong.

As seen from the above-given remarks, claim 1 is allowable over Mumford view of Hermelin. Since claim 1 is allowable over Mumford in view of Hermelin, dependent claim 20 is allowable over Mumford in view of Hermelin as well.

Whether claim 4 is obvious over Mumford in view of Hermelin and further in view of Davidowitz under 35 U.S.C. §103.

Claim 4 is not obvious over Mumford in view of Hermelin and
further in view of Davidowitz under 35 U.S.C. §103:

Davidowitz does not make up for the deficiencies of Mumford and Hermelin. Since claim 1 is allowable, dependent claim 4 is allowable as well.

Based on the above-given remarks, the honorable Board is therefore respectfully urged to reverse the final rejection of the Primary Examiner.

If an extension of time is required for this submission, petition for extension is herewith made. Any fees due should be charged to Deposit Account No. 12-1099 of Lerner Greenberg Stemer LLP.

Respectfully submitted,

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Claims Appendix:

1. A suppository package comprising:

a package having a chamber formed therein, said chamber containing a suppository therein, said package having a second chamber formed therein, said second chamber being separate from said chamber and disposed within said chamber, and said second chamber containing a lubricant therein.

4. The suppository package according to claim 1, wherein the lubricant is a greasy ointment or Vaseline.

20. The suppository package according to claim 1, wherein said chamber and said second chamber are constructed for being opened simultaneously.

Evidence Appendix

No evidence pursuant to §§ 1.130, 1.131, or 1.132 or any other evidence has been entered by the Examiner and relied upon by appellant in the appeal.

Related Proceedings Appendix

No prior or pending appeals, interferences or judicial proceedings are in existence which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

Accordingly, no copies of decisions rendered by a court or the Board are available.